The opinion in support of the decision being entered today was *not* written for publication and is <u>not</u> binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UWE HANSMANN, LOTHAR MERK and THOMAS STOBER

Appeal No. 2006-0986
Application No. 09/745,818

ON BRIEF

Before OWENS, GROSS and LEVY, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from a rejection of claims 1-24, which are all of the pending claims.

THE INVENTION

The appellants claim a system, contactless label chipcard, device, method and computer program product for executing payments. Claim 1, which claims the system, is illustrative:

1.   System comprising:

a contactless label chipcard attached to a product containing at least information identifying said product and payment status thereof, and a component for execution of an update of the payment status of said product;

a device for reading and initiating update of the payment status comprising at least:

a contactless reader for reading information stored in said contactless label chipcard

a component for generating an invoice based on said information received from said contactless label chipcard

a component for checking payment of said invoice

a component for initiating update of the payment status in the contactless label chipcard.

THE REFERENCES

Boers et al. (Boers)	5,637,846	Jun. 10, 1997
Brookner et al. (Brookner) (PCT application)	WO 99/66456	Dec. 23, 1999

THE REJECTION

Claims 1-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boers in view of Brookner.

OPINION

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 13-15 and 22-24. Claim 1 requires a contactless label chipcard which is attached to a product and contains 1) information identifying the payment status of the product, and 2) a component for executing an update of the payment status of the product. Claim 1 also requires a device for reading and initiating update of the payment status.

Claim 13 claims a contactless product label chipcard for use in a system according to claim 1. Claim 14 claims a device for reading and initiating payment status for use in a system according to claim 1. Claim 15 claims a method for executing payments in a system as claimed in claim 1. Claims 22-24 claim a computer program product stored in the internal memory of a computer containing parts of software code for performance of the method according to, respectively, claim 15, claim 17 (which depends from claim 16 which depends from claim 15), and claim 20 (which depends from claim 15). Because the contactless product label chipcard in claim 13, the device in claim 14, and the methods in claims 15 and 22-24 are for use with the system of claim 1, we consider the contactless label chipcard required by those claims to include all of the contactless label chipcard limitations recited in claim 1.[1]

Boers discloses a self-service store wherein customers use a portable scanner to scan articles which typically are coded using a barcode but, in principle, may be coded with other coding systems such as magnetic codes and binary codes stored in a chip (col. 3, line 66 - col. 4, line 13). After articles to be purchased have

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[1] If the appellants are of the view that independent claims 13-15 and 22-24 do not require all of the contactless label chipcard limitations recited in claim 1, then the appellants and the examiner should address on the record the scope of claims 13-15 and 22-24 as to those limitations.

been scanned, the customer takes the scanner to a readout station

where the data from the scanner is read and sent to a computer

which determines the amount to be paid for the articles (col. 5,

lines 6-38).

Brookner discloses a system and method for generating indicia

onto a medium such as a label which serves as proof of payment such

as postage (page 1, lines 2-5). Before a label device prints the

indicia on the label, the payment is accounted for by communication

between the label device and a postal security device that stores

funds for ready dispensation (page 2, lines 19-22; page 3,

lines 1-6).

The examiner argues that Boers discloses, at column 4,

lines 1-14 and column 5, lines 15-65, a contactless label chipcard

which is attached to a product and contains at least information

for identifying the product and payment status thereof, and a

component for execution of the update of the payment status of the

product (answer, page 3). The relied-upon portions of Boers

disclose that in principle, products can be coded with binary codes

stored in a chip, and disclose a scanner readout station. Those

portions do not disclose that the chip contains either information

for identifying the payment status of the product or a component

for executing an update of the payment status of the product.

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The examiner argues that Brookner discloses, in the abstract and at page 2, line 19 to page 3, line 7, a method and system for generating indicia indicative of payment comprising a component for initiating update of the payment status in a contactless label (answer, page 7). Those portions of Brookner disclose using a label device to print indicia on a label, but do not disclose that the label includes a component for initiating update of payment status.

The examiner argues that the indicia on Brookner's label can be used to update the payment status by scanning the label (answer, page 8). The examiner, however, has not shown that Brookner discloses that the indicia can be used to update the payment status of the product, or that the indicia inherently have that characteristic. The examiner's mere speculation to that effect is not sufficient. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962).

For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.

DECISION

The rejection of claims 1-24 under 35 U.S.C. § 103 over Boers

in view of Brookner is reversed.

REVERSED

TERRY J. OWENS   )
Administrative Patent Judge   )
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)
ANITA PELLMAN GROSS   ) BOARD OF PATENT
Administrative Patent Judge   )   APPEALS
)   AND
) INTERFERENCES
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)
STUART S. LEVY   )
Administrative Patent Judge   )

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Kevin P. Radigan, Esq.
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, NY 12203